

## **Remarks**

### **Introduction**

Claims 81-86, 89-92, 94-108, 112, 113, 121-130, 132, 134-137, 140, 150, 160-171, 173, and 177-211 were pending, and claims 90, 99, 187, 189, 204, 205, and 207 have been withdrawn from consideration.

By way of this response, claims 81, 112, 121, 124, 161, 182, 194, and 200 have been amended; claims 181 and 199 have been cancelled without prejudice; and claims 212-221 have been added. Support for the amendments to the claims can be found in the application as originally filed, and care has been taken to avoid introducing new matter.

As discussed herein, independent claims 81 and 194 have been amended to include the allowable subject matter of claims 181 and 199, respectively. Claims 182 and 200 have been amended to be consistent with the amendments to claims 81 and 194, respectively. Claims 112, 121, 124, and 161 have been amended as suggested by the Examiner. New claims 212, 214, and 218 are being presented and correspond to allowable claims 103, 127, and 167 rewritten in independent form. Claim 213 includes the subject matter of allowable claim 104; claims 215-217 include the subject matter of allowable claims 128-130; and claims 219-221 include the subject matter of allowable claims 168-170.

Applicant submits that the amendments presented herein put this application in condition for allowance, and do not introduce new matter or raise new issues. Applicant respectfully requests entry of this Amendment and reconsideration of the objections and rejections.

In view of the amendments presented herein, claims 81-86, 89-92, 94-108, 112, 113, 121-130, 132, 134-137, 140, 150, 160-171, 173, 177-180, 182-198, and 200-221 are pending.

### **Allowable Subject Matter**

The Office Action indicates that claims 103, 104, 127-130, 167-170, 181, 182, 199, and 200 include allowable subject matter and would be allowable if rewritten to be in independent form and including all of the limitations of any base claim and intervening claims.

As indicated above, independent claim 81 has been amended to include the allowable subject matter of claim 181. Independent claim 194 has been amended to include the allowable subject matter of claim 199. Dependent claims 181 and 194 have been cancelled without prejudice.

Allowable claim 103 has been rewritten as new independent claim 212. Claim 212 includes all of the limitations of the base claim 81 and any intervening claim. The subject matter of allowable claim 104 is included in new claim 213.

Allowable claim 127 has been rewritten as new independent claim 214. Claim 214 includes all of the limitations of the base claim 81 and any intervening claim. The subject matter of allowable claims 128-130 is included in claims 215-217.

Allowable claim 167 has been rewritten as new independent claim 218. Claim 218 includes all of the limitations of the base claim 81 and any intervening claim. The subject matter of allowable claims 168-170 is included in claims 219-221.

#### Election/Restriction and Rejoinder

Claim 90, 99, 187, 189, 204, 205, and 207 have been withdrawn from consideration.

Claims 90, 99, 187, and 189 depend from claim 81, and claims 204, 205, and 207 depend from claim 194. Claims 81 and 194 are generic to dependent claims 90, 99, 187, 189, 204, 205, and 207. As discussed herein, applicant submits that independent claims 81 and 194 are in condition for allowance.

Applicant submits that the present application includes allowable claims that are generic to all of the claimed species identified by the Examiner, that all the claims to the species are written in dependent form or otherwise include all the limitations of the allowable generic claims, and that the claimed species do not exceed a reasonable number. Therefore, applicant respectfully requests the Examiner to withdraw the species restriction and allow all of the presently pending claims (MPEP § 806.04(d)). Applicant respectfully requests that claims 90, 99, 187, 189, 204, 205, and 207 be rejoined with the present allowable generic claims, as set forth above (MPEP § 821.04(a)).

#### Claim Objections

Claims 112, 121, 124, and 161 were objected for reciting "and/or".

Claims 112, 121, 124, and 161 have been amended by replacing "and/or" with --or--, as suggested by the Examiner. Thus, these claims encompass either one of the recited elements/limitations, or both.

In view of the above, applicant submits that the objection to the claims have been overcome.

Rejections Under 35 U.S.C. §§ 102/103

Claims 81-84, 89, 91, 92, 94-95, 97, 105, 106, 108, 183, 185, 188, and 191 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,964,748 (hereinafter Peyman '748), or in the alternative under 35 U.S.C. § 103(a) as being obvious over Peyman '748. Claims 96, 100-102, 150, 178, 179, and 184 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyman '748 in view of U.S. Pat. No. 4,959,353 (hereinafter Brown '353). Claim 98 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyman '748 in view of U.S. Pat. No. 6,880,558 (hereinafter Perez '558). Claims 121-123, 126, 132, 140, 160, 163, 165, 166, 173, and 192 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyman '748 in view of U.S. Pat. No. 6,335,006 (hereinafter Miller '006). Claims 112, 113, 124, 125, 134-137, 161, and 162 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyman '748 in view of Miller '006 and further in view of U.S. Pub. No. 2003/0220653 (hereinafter Perez '653). Claim 164 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyman '748 in view of Miller '006 and further in view of Perez '558. Claim 171 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyman '748 in view of Miller '006 and further in view of U.S. Pub. No. 2004/0015234 (hereinafter Peyman '234). Claim 177 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyman '748 in view of Miller '006 and further in view of U.S. Pat. No. 4,959,353 (hereinafter Brown '353). Claims 180, 192-196, 201, 202, 206, and 209 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyman '748 in view of U.S. Pat. No. 5,984,914 (hereinafter Cumming '914). Claim 211 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyman '748 in view of Cumming '914 and further in view of U.S. Pat. No. 6,361,560 (hereinafter Nigam '560). Claims 197 and 198 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyman '748 in view of Cumming '914 and further in view of Perez '653. Claims 186 and 190 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyman '748 in view of U.S. Pub. No. 2002/0039788 (hereinafter Isseroff '788). Claims 203 and 208 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyman '748 in view of Cumming '914 and further in view of Isseroff '788.

Claim 210 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyman '748 in view of Cumming '914 and further in view of Brown '353.

Applicant traverses the rejection as it relates to the previous claims, and reserves the right to pursue the subject matter of the previous claims in one or more continuing applications to be filed at applicant's discretion. Among other things, and as explained in applicant's previous response, the primary reference used to reject the previous claims, Peyman '748, does not disclose, teach, or even suggest any method that includes inserting a lens into a pocket created between a corneal epithelium and Bowman's membrane. Peyman '748 specifically discloses that the pockets formed in the eye are located beneath Bowman's membrane (i.e., between Bowman's membrane and descemet's membrane). Peyman '748 discloses pockets in a different region of the eye compared to that recited in the previous claims. None of the other cited references provide the deficiencies apparent in Peyman '748. Applicant submits that Peyman '748, taken alone or in any combination with the other cited references, does not disclose, teach, or suggest all of the elements recited in the previous claims, and therefore the previous claims are patentable over Peyman '748, taken alone or in any combination with the other cited references, under 35 U.S.C. §§ 102 and 103.

However, to advance the prosecution of the present application, independent claims 81 and 194 have been amended to recite the allowable subject matter of claims 181 and 199, respectively. In addition, allowable claims 103, 104, 127-130, and 167-170 have been rewritten as new claims 212-221.

In view of the above, applicant submits that the present claims are in condition for allowance.

#### Double Patenting

Claims 81-83, 86, 89, 90, 96, and 108 have been provisionally rejected on the ground of obviousness-type double patenting over claims 1, 2, 5, 8-11, 13, 15, and 16 of U.S. App. No. 11/183,191.

Applicant does not concede to the correctness of the rejection. However, to advance the prosecution of the present application, independent claim 81 has been amended to recite the allowable subject matter of claim 181.

In view of the above, applicant submits that the present claims are not subject to obviousness-type double patenting, and applicant requests that the provisional rejection be withdrawn.

Request for listing of copending applications

The Examiner has requested a listing of copending applications that set forth similar subject matter to the present claims. Applicant assumes that the Examiner is requesting a listing of applications for which the present applicant has filed.

The following applications may describe subject matter that is similar to the present claims:

11/128,824, filed May 13, 2005  
11/203,685, filed August 12, 2005  
11/183,191, filed July 14, 2005  
60/671,819, filed April 15, 2005  
60/771,668, filed February 8, 2006  
60/790,874, filed April 10, 2006  
60/747,355, filed May 16, 2006  
11/427,293, filed June 28, 2006

The undersigned believes that each of the above-identified applications (filed after the present application) is stored in image format in the IFW system. To the extent that one or more of these applications is not available to the Examiner, applicant respectfully requests the Examiner to telephone the undersigned at the number below to address this matter.

Conclusion

In view of the foregoing amendments and remarks, applicant submits that the present application, including claims 81-86, 89-92, 94-108, 112, 113, 121-130, 132, 134-137, 140, 150, 160-171, 173, 177-180, 182-198, and 200-221, is in condition for allowance. Notice of which is respectfully requested. If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicant's undersigned representative invites the Examiner to telephone him at the number provided below.

Applicant is submitting payment for the additional claims presented herein via credit card. However, the Commissioner is hereby authorized to charge any additional fees necessary, or credit any overpayment, to Deposit Account No. 50-4064.

Respectfully submitted,

Date: December 15, 2006

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